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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 714

UNION CARBIDE & CARBON CORPORATION,

Petitioner,

v.

GRAVER TANK & MFG. CO., INC., and
THE LINCOLN ELECTRIC COMPANY,

Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

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May 16, 1952

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This is an action to recover, under guise of equivalents, the process claims of Jones patent 2,043,960 which this Court held invalid in 336 U. S. 271.

All those claims have been expunged from the patent.

Four composition claims have been held valid. 336 U.S. 271, 339 U.S. 605.

The charge in the present proceedings brought by Petitioner Union Carbide & Carbon Corporation is that certain electric welding fluxes manufactured by Respondent The Lincoln Electric Company and one of them used by Respondent Graver Tank & Mfg. Co., Inc., infringe those four claims and that Respondents are, therefore, in contempt. The trial court so held. The Court of Appeals reversed. It held the claims limited by the history of their allowance in the Patent Office, the representa-

tions made to sustain them, and the basis on which adjudication of their validity was obtained, to exclude, as a matter of law, the presently accused fluxes.

SUMMARY STATEMENT OF THE CASE.

One would suppose from reading the Petition that Union Carbide & Carbon Corporation has a patent upon the process of submerged-arc automatic welding, and that use of any flux therein which will produce a good weld invades its monopoly.

That, to be sure, was the monopoly Union Carbide for many years exploited. But that is precisely the monopoly this Court denied it. (336 U.S. 271, 278)

What Petitioner does own is a monopoly of a specific "composition of matter." That monopoly, this Court held, is "claimed and bounded by the composition claims Nos. 18, 20, 22 and 23." (336 U. S. 271, 274) Each of those four claims calls for a welding flux composed of a "major proportion of alkaline earth metal silicate."

Union Carbide says the accused fluxes are the same as the 660 flux this Court held an equivalent. Petitioner fails to point out that the 660 flux was a prefused manganese silicate flux whereas the accused fluxes are mixtures of several ingredients stuck together or agglomerated by a binding agent.*

As the Court of Appeals (Judges Major, Kerner, and Lindley sitting) said:

> "It may be noted, and we think this is without dispute, that plaintiff's [*i.e.*, Union Carbide's] flux, with its 'alkaline earth metal silicates,' as well as defend-

* Petitioner's expert, Dr. McCaughey, described the agglomerated nature of the accused fluxes:

> "Your fluxes are composed of granules—they are granular in character, to start with, and then each particle of that grain is microgranular, and these are the discrete particles which form the coarse granular aggregate." (R. 371)

> ants' [*i.e.*, Lincoln's] 660 flux, held to infringe by use of its manganese silicate, adjudicated to be an equivalent, are both completely reacted and when fused, consist of chips of homogenous, glassy material described by the patent as 'characterized by vitreous fracture' (*i.e.*, broken glass). On the other hand, the accused fluxes consist of non-homogenous granules composed of particles of the different components held together by a binder but visibly retaining their individual characters. This difference is due to the fact that the chemical reaction between the components of plaintiff's welding composition are complete before use, while in the accused compositions the chemical reaction is not complete before use." (R. 1133).

Being bound mixtures rather than fused silicates, none of the presently accused fluxes meets the present claims calling for "a major proportion of * * * silicate." Each contains a major proportion of non-silicate materials and only a minor proportion of silicates of any kind. Petitioner urges that the non-silicate components of the accused fluxes should be considered the equivalent of the silicate called for by the claims.

The Court of Appeals rejected that pretension. It pointed out that Petitioner had sought in the Patent Office claims to materials which form silicate during welding. Such claims would have covered the materials Respondents used and would have covered many prior-art disclosures as well. But such claims were rejected by the Patent Office and by amendment were confined to "silicate", the end product of complete chemical reaction, or fusion, of the materials before use in welding. On the ground the claims were thus limited they were held valid in the prior proceedings. The Court of Appeals said:

> "In our opinion, the application of the doctrine of equivalency in this case is to ignore the teachings of the patent, the representation upon which the claims in suit were allowed and, more pointedly perhaps, the representations by which their validity has been sustained in the courts." (R. 1144).

In so holding, the Court of Appeals applied (R. 1135) the controlling decision of this Court, *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, holding that the doctrine of equivalents cannot be used to recapture what the patentee has surrendered by amendment in the Patent Office.

That case is precisely in point. It compelled a judgment of non-infringement. If that case does not control, this Court is entitled to be told why. Yet the case is not mentioned in Union Carbide's Petition or Brief. Petitioner not only is silent here, but made no attempt to persuade the Court of Appeals of its alleged error by petition for rehearing.

Instead, Petitioner pretends this is a case of conflicting evidence as to which the trial judge made a choice which should be affirmed under Rule 52(a). Not so. The very foundation of the Court of Appeals decision is that on the trial court's findings the accused fluxes are outside the claims.

QUESTIONS PRESENTED.

Union Carbide ignores the only questions presented by the record. They are:

1. Whether composition claims held valid may be read to recapture process claims adjudicated invalid.
2. Whether the doctrine of equivalents may be used to read into composition claims subject matter expressly excluded from the claims, disclaimed in

the specification, disclaimed by amendment in the Patent Office to procure their allowance, and again disclaimed in the courts to induce an adjudication of their validity.

Union Carbide discusses many matters, but not the issues on which the case was decided.

We begin therefore with:

THE CLAIMS.

The four limited composition claims held valid in the prior proceedings, and now charged as infringed, are claims 18, 20, 22, and 23. These claims read:

"18. A composition for electric welding **containing a major proportion of alkaline earth metal silicate,** and being substantially free from uncombined iron oxide and from substances capable of evolving gases under welding conditions.

20. A composition for electric welding containing a fluoride and a **major proportion of alkaline earth metal silicate,** and being substantially free from uncombined iron oxide and from substances capable of evolving gases under welding conditions.

22. A finely-divided unbonded fusible electric welding composition containing a fluoride and a **major proportion of an alkaline earth metal silicate.**

23. A finely-divided unbonded fusible composition for use in electric welding employing a bare metal electrode as a source of weld metal, said composition being substantially free from substances capable of evolving a detrimental quantity of gas under welding conditions and containing calcium fluoride and a **major proportion of one or more alkaline earth metal silicates.**"* (R. 1154.)

* Emphasis supplied throughout except as otherwise noted.

THE PRIOR PROCEEDINGS.

In the prior proceedings, Petitioner claimed a monopoly on Robinoff's submerged-arc process. This Court held that process was invented by others. (336 U.S. 271, 277-278). But Union Carbide has not given up its attempt to monopolize it.

Formerly Union Carbide attempted to sustain the process claims on the ground they distinguished from Robinoff because they covered an arcless process of welding. Such "idea of a radically different scientific principle," the trial court held, "came not from the inventors, but from plaintiff's patent solicitors" (R. 10). The trial court concluded the process actually used was Robinoff's. It held the process claims invalid. This Court affirmed.

Now Union Carbide attempts to recover the lost process and its broad composition claims by making the four remaining composition claims cover, in the name of the doctrine of equivalents, any flux which will work. Accordingly, the same recital of merit previously advanced to sustain the process is now pressed into service with scarcely change of word or picture to inflate the composition claims to cover the process. Union Carbide's theory is, as was the trial court's, that things that "do the same work in substantially the same way" (as both must do, for both use the Robinoff process), and "accomplish the same result" (as both necessarily do, for both produce a good sound weld and would not be used if they did not), are, therefore, equivalents "even though they differ in name, form or shape." If this be so, Union Carbide will effectively have recovered a monopoly of the process invented by others, because any workable flux will then infringe its patent.

HOLDING OF THE TRIAL COURT.

It made no difference to the trial judge—retired Judge Charles A. Dewey, DesMoines, Iowa, sitting by designation in place of Judge Luther A. Swygert who heard the prior proceedings—what was disclosed by the prior art. He refused to consider the limitations written into the claims in the Patent Office and insisted on by the Petitioner in the courts to sustain them. His view was:

> "you can't introduce any evidence to show any limitation on these claims." (R. 635).

The trial judge thus set the claims at large; then he freed the patent from those claims so expanded. In short, he conducted a general gaol delivery releasing this patent—and, were his decision to stand, others as well—from confining statutes. He said:

> "the patent itself transcends in importance the compositions which are set out in the claims of the patent" (R. 1036-7)

and held:

> "the claims are in truth subordinate to the invention shown by the patent." (R. 1037).

The trial court drew no distinction between the four limited claims charged to be infringed on the one hand and on the other the invalid claims and extensive patent specification (which included descriptions of the Robinoff process, the prior art, and other fluxes, all of which this Court had held were not patentable to Petitioner). This led to the trial court's generalizations about "copying", for even Robinoff would have been "copying" this specification in practicing his own process.

The trial judge made no finding that respondents Lincoln and Graver used the forbidden material of the claims. Even Union Carbide does not now claim they did. In-

stead, the trial court held Lincoln and Graver, "in relying upon the opinion of their counsel" that they did not infringe:

> "should have known that the patent was much broader than the claims" (R. 1040)

and that:

> "common sense should have told them they were getting too close to the patent" (R. 1040).

The Court of Appeals held this would not do. It held infringement must be measured by the claims construed in the light of their history in the Patent Office and in the courts. This conforms to this Court's command that:

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case." (339 U.S. 605, 609).

HOLDING OF THE COURT OF APPEALS.

The Court of Appeals rejected no finding of the trial court. It redrew none. It sorted out the facts found, from the debris to which the trial judge reduced the patent law. It held that, however great the invention, it nevertheless has bounds.

The Court of Appeals (R. 1136) applied the principle this Court applied in *Exhibit Supply Co.* v. *Ace Patents Corp.*, (1942), 315 U.S. 126, 136:

> "Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment."

On the basis of the facts found by the District Court, the Patent Office file history, and the representations

made in briefs previously filed by Petitioner to obtain its adjudication of validity, the Court of Appeals rejected Petitioner's all-embracing claims of monopoly with this statement:

> "Thus, in view of the unequivocal representations heretofore made, we think it too late to contend that complete chemical reaction and fusion before use in welding was not an essential requirement of the invention. It was this characterization by the patentee which distinguished it from the prior art, both in the Patent Office and before the courts." (R. 1143).

The Court of Appeals was right.

ARGUMENT.

I. THE COURT OF APPEALS RIGHTLY HELD THE CLAIM REQUIREMENT OF "A MAJOR PROPORTION" IS NOT SATISFIED BY A MINOR PROPORTION.

The Court of Appeals first examined Union Carbide's contention, strenuously urged to the trial court and to the Court of Appeals, that percentages of silicate as low as 10% constitute "a major proportion" of the accused fluxes.

The Court of Appeals rejected this contention. Union Carbide now abandons the point. (Pet. Br. p. 41). It no longer urges infringement on this ground. It is content with the conclusion the Court of Appeals reached, except only to criticize now as having "no relevance" the Court's discussion of the position Petitioner was then strenuously urging before it.

II. THE COURT OF APPEALS RIGHTLY HELD THAT RECOURSE MAY NOT BE HAD TO THE DOCTRINE OF EQUIVALENTS TO RECAPTURE CLAIMS WHICH HAVE BEEN DISCLAIMED.

The Court of Appeals then considered Union Carbide's second point, that, lacking "a major proportion of * * * silicate," the claims nevertheless encompass "as an equivalent * * *of silicate" the ingredients Lincoln used. This is the only point Union Carbide now urges.

Admittedly the ingredients of the accused fluxes form silicate under the heat of the arc during the welding operation itself. They are mixtures of the same ingredients, manganese ore and silica, and in the same proportions,* disclosed by the expired Miller patent 1,754,566 (II.O.R. 1351) stuck together into granular particles as taught by Lincoln's Landis-Peters patent 2,474,787. (Ex. D-58).

The principal point of difference (and there are others) between the accused fluxes and the flux of the patent lay in the fact that in the case of Union Carbide's patent (as well as Lincoln's prior 660 flux) the components, which Union Carbide now refers to as "incipient silicates", were chemically reacted into silicate **before** use as a flux whereas in the case of the now-accused fluxes the reaction between the components to form silicate occurs **during** the welding operation itself.

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* Union Carbide, insensitive to the limitations it accepted on its claims in the Patent Office, would now arrogate to its patent not only the materials and proportions Respondents used but also the simple process step of heating to drive off water and undesirable gases (which Union Carbide now calls "under-cooking"). Both are old. The materials and proportions were taught by expired Miller 1,754,566 and Hodge 1,979,264. (II O.R. 1352, lines 45-63, 91-100; Ex. D-70). The "under-cooking" step was taught by Whitcomb 277,393, Roberts 1,283,909, and Miller 1,741,031. (II. O.R. 1325, 1326, 1347). Union Carbide uses the term "under-cooking" in an attempt to conceal the distinction between the old drying step and the complete "chemical reactions between the components" required by the patent to form the silicate of the claims. This can be effected only by fusion. As Union Carbide's Dr. Willard put it, "to do that, fusion is necessary." (I. O.R. 290).

Does this make a difference?

The Court of Appeals held it crucial. It noted that the Patent Office denied Petitioner claims to the components. The Patent Office allowed the claims only when redrawn to confine them to the reacted product, silicate. (II O.R. 1052, 1062-4, 1068-70, 1120, 1134, 1136).

The Court of Appeals contrasted the completed chemical reaction between the components **before** use of the material as a flux with reaction **during** welding. It observed this was the precise difference relied upon to obtain the patent, was required by the Patent Office to distinguish from the prior art, was insisted upon in representations to the Patent Office and to every court which has passed on the validity of these claims, and was the specific ground on which the validity of the claims was sustained. (R. 1141-1144).

The Court of Appeals held as a matter of law that the doctrine of equivalents, however broad, cannot restore to the claims allowed that which the patentees surrendered to obtain them. It held the doctrine of equivalents cannot bring within the reach of the claims the components which form silicate when reacted together (as contrasted with the reaction product, silicate).

The Court of Appeals rightly so held because:

1. The Claims in Express Terms Are Limited to Fluxes Containing A Major Proportion of Silicate.

Each of the claims now charged as infringed is by its express terms limited to fluxes containing:

"a major proportion of * * * silicate."

Even Petitioner, Union Carbide, now concedes the accused fluxes do not respond to this requirement.* It argues

* When it brought this proceeding Union Carbide asserted the contrary. (R. 31-2). But it failed in its proof. It, therefore, now abandons the point.

only that the materials Lincoln used should be deemed an equivalent of silicate.

2. The Specification in Mandatory Language Confirms Such Requirement of The Claims.

The specification expressly requires the components of the flux to be reacted together to form silicate before the material is used as a flux. It says:

> "The chemical reactions **between the components** of the welding composition **must be completed** before it is used in welding. Failure in this regard most surely invites porosity." (Ex. P-10, p. 2, col. 1, lines 42-5; R. 1150).

A silicate is the product resulting from reacting a basic ingredient (in this case manganese oxide, *i.e.*, manganese ore) with an acidic ingredient (in this case silicon dioxide, *i.e.*, silica, quartz, or sand). The result of reacting these two ingredients together is a wholly new and different product, namely, silicate. As Petitioner's expert, Dr. Willard, put it:

> "A reaction in the chemical sense is one in which there has been a chemical combination between two substances to form another substance with totally different properties." (R. 165).

Throughout, the specification requires that the material be "fused" to form silicate prior to use. E.g., P. 1150-1151, p. 2, col. 2, lines 1-8, 38-9, 51, 53-54, 56, 57; p. 3, col. 1, lines 4-14, 21-33. This, the inventors said, is done "by prefusing a mixture of the constituents, preferably in an electric furnace." (R. 1151, p. 3, col. 1, lines 12-14).

For example, referring to the prior 660 flux, Petitioner's expert, Dr. Willard, testified:

> "This is a prefused material. We know that because unless the elements are combined at a high tempera-

ture and fused, there is no reaction between them." (I. O.R. 290).

Thus, it is not the silicate-forming components the patent demands; it is the resulting product of the reaction between the components, namely silicate, the patent subjects to its monopoly.

Petitioner recognizes that the patent cannot embrace fluxes not composed principally of silicate. Its own evidence establishes that the accused fluxes are principally composed of non-silicate materials. Petitioner attempts to bridge this fatal gap between the patent's prefused silicate flux and the accused fluxes by a shabby semantic trick, *i.e.*, calling the components "incipient silicates."

There are no such things as "incipient silicates."

Silicates are produced by a chemical reaction between the respective components which at the instant of reaction cease to exist as such. Before the reaction the components are not silicates; they cannot simultaneously be non-silicates and silicates.

The use of the term "incipient silicates" is deceptive, unscientific, and unjustified. It is an afterthought. Nowhere in the testimony of Union Carbide's principal expert, Dr. Willard, or of any other witness is the term used. It is an artifice.

This deception is the basis for the chart reproduced in the Petition (p. 12). Petitioner, recognizing that its proofs establish that the accused fluxes are composed of "a major proportion" of non-silicate materials, and now conceding the ordinary meaning of the words "a major proportion", attempts to give elasticity to the scientific term "silicates" by inventing the non-existent variant, "incipient silicates".

But, although in the chart Petitioner applies the term "incipient silicates" to the non-silicate materials which compose the larger part of the accused fluxes, the same substances in the Hodge prior-art flux it calls "unrelated materials". (Ex. D-70, p. 2, lines 63-65, 126-132).*

A Petition in this Court marked by such lack of candor should be, without more, denied.

3. The Patent Office Required Patentee to Confine Its Claims to The Reacted Product, Silicate.

Petitioner limited its claims to the reacted product, silicate, because the Patent Office required it to do so. It sought a claim to cover the components which under the heat of the welding arc form silicate. This would have given it a monopoly of most of the prior art; it was repeatedly refused by the Patent Office. Union Carbide accepted the more limited claims.

The first four claims in the original, subsequently abandoned, first application defined the flux as:

> "consisting of two components, one acid and one basic." (E.g., claim 1, II. O.R. 1052).

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* Petitioner's chart misrepresents the proofs of both parties. The columns representing Petitioner's proofs show more than 60% silicate in the 760 and 780 fluxes. Dr. Willard, the only witness for Petitioner testifying as to quantities, admitted he could not find as much as 50% of silicate in any of the fluxes. (R. 304). The columns representing Respondents' proofs are also false. In 780, for example, the chart assigns to respondents' proofs a total of 54% to 59% silicate; Respondents' proofs actually showed 20% to 32%. (Ex. D-67) Repondents' proof as to 840 flux showed a maximum of 20.8% silicates of all kinds. (R. 877-881; Ex. D-68). Petitioner's specious "adulterant" device would raise this total to 26%. But the chart for some reason shows 31%.

In short, (1) the only controversy among the witnesses was as to how minor was the silicate content of the fluxes; it is admitted that no flux contained a major proportion; and (2) Petitioner has abandoned its contention that the fluxes contain sufficient silicate to satisfy the claims. Petitioner's decision in this Court to base its case solely upon its "incipient silicate" ruse is an admission that its chart falsely portrays the proofs.

These claims were rejected. (II. O.R. 1062). They were then cancelled. (II. O.R. 1063). Simultaneously additional claims 22 to 27 were added by amendment, calling for:

> "a compound **having both a basic component and an acid component**" (II. O.R. 1064).

The Examiner rejected the claims so amended as:

> "inaccurate since applicant's compound in its final form **does not contain an acid and a base** but rather contains the **reaction product** of these, *ie.*, a salt" [that is, silicate] (II. O.R. 1068).

Thereupon claims 22, 23, 26, and 27 were cancelled and claims 24 and 25 were amended. Applicants told the Patent Office:

> "Claims 24 and 25 are amended to specify that the compound in question is a salt, as suggested by the Examiner" (II O.R. 1070).

The application was thereupon abandoned.

No claim to the components was presented in the second application filed the following year.

However, in the third application, on which the patent ultimately issued, filed two and a half years after the first, claim was again asserted to a:

> "composition containing a major proportion of a compound having both a basic component and an acid component." (II O.R. 1120)

This was rejected. The Examiner said:

> "Certain of these claims indicate that flux components are acid and basic and that chemical reaction therebetween has been previously completed. Such being the case it appears that the flux, *per se,* is neither acid nor basic nor that it is apparent from inspection of that flux as to what were its original component elements." (II O.R. 1134)

The claim to a flux composed of materials which, when chemically reacted together, form a silicate was thereupon cancelled. (II O.R. 1136) The patent issued without any such claim.

Having sought and having been denied claims covering the component materials to form a silicate, and having accepted claims confined to the reaction product, silicate, Union Carbide cannot now have its patent read to cover not only the silicate it claimed but also the components it abandoned.

One reading the argument now tendered by Union Carbide in support of its free-hand translation of the allowed claims would not know this Court has spoken on the point. The controlling authority, *Exhibit Supply Co.* v. *Ace Patents Corp.* (1942), 315 U.S. 126, is not even mentioned. In that case this Court held (p. 136):

> "By the amendment, he [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference. * * * As the question is one of construction of the claim, it is immaterial whether the examiner was right or wrong in rejecting the claim as filed. * * * It follows that what the patentee, by a strict construction of the claim, has disclaimed * * * cannot now be regained * * *."

Nor can a claim to the components required to form silicate be recaptured in the name of equivalents. This, too, was settled in the *Exhibit Supply* case. The Court said, 315 U.S. 126, 137:

> "what the patentee * * * has disclaimed * * * cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed."

In *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, (1940), 311 U.S. 211, this Court similarly held (p. 221):

> "The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. * * * The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest."

This is familiar law*. It is the law the Court of Appeals applied.

4. The Claims were Held Valid Over the Prior Art on the Ground that They Did Not Cover Components of Silicate.

Judge Swygert, in sustaining these claims, distinguished the prior art by holding that the patent in suit requires complete reaction between the acidic and basic components of the flux **before** being used in welding, as contrasted with the prior art teaching of reaction between

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* This Court has consistently applied this rule:
Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp. (1935), 294 U.S. 477, 492;
Keystone Driller Co. v. Northwest Engineering Corp. (1935), 294 U.S. 42, 48;
Smith v. Magic City Kennel Club, Incorporated (1931) 282 U.S. 784, 789-90;
I.T.S. Rubber Company v. Essex Rubber Company (1926) 272 U.S. 429, 443-4;
Weber Electric Company v. E. H. Freeman Electric Company (1921), 256 U.S. 668, 677;
Hubbell v. United States (1900), 179 U.S. 77, 80-4;
Morgan Envelope Company v. Albany Perforated Wrapping Paper Company (1894), 152 U.S. 425, 429;
Corbin Cabinet Lock Company v. Eagle Lock Company, (1893), 150 U. S. 38, 40;
Knapp v. Morss (1893), 150 U.S. 221, 224-5;
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Phoenix Caster Company v. Spiegel (1890), 133 U.S. 360, 368;
Roemer v. Peddie (1889), 132 U.S. 313, 316-7;
Sutter v. Robinson (1886), 119 U.S. 530, 541;
Shepard v. Carrigan (1886), 116 U.S. 593, 597-8;
Sargent v. Hall Safe and Lock Co. (1885), 114 U.S. 63, 86.

the components **during** welding (R. 17-18). As the Court of Appeals noted:

> "Judge Swygert found that plaintiff had developed a welding composition 'in which all reactions were entirely completed by prefusing at high temperature.' In fact, it was this complete chemical reaction prior to use by which Judge Swygert distinguished the composition claims from the prior art. 86 F. Supp. 200." (R. 1142.)

The distinction between reaction **before** welding and reaction **during** welding was thus the basis on which Judge Swygert, affirmed by this Court, sustained the claims in suit.

5. Petitioner Obtained Its Judgment of Validity On The Representation That The Claims Excluded Components.

Petitioner obtained its adjudication of validity upon the premise that the claims were limited to welding fluxes in which the chemical reactions had been completed before use in welding. Petitioner disclaimed then the "incipient silicates" it now seeks to read back into the claims.

The Court of Appeals noted, for example, (R. 1142) that in the earlier proceeding in which the validity of the claims was challenged, Petitioner pointed to the requirement of the patent that:

> "The chemical reactions between the components of the welding composition must be completed before it is used in welding"

and that Petitioner then asserted that:

> "Such imperative language puts that portion of the specification in the same category as a 'disclaimer' of anything which does not conform"

to the quoted requirement that the reactions between the components must be completed.

In this Court the same distinction was stoutly asserted to sustain the claims.* Thus, in its brief in this Court (Nos. 184 and 185, October Term, 1948) Union Carbide, then appearing through The Linde Air Products Company, respondent there, told this Court, with underscoring to emphasize the difference, that (p. 56):

> "the preferred form of the Miller patent was a coating containing acidic and basic constituents which would react during the welding operation—whereas the Jones et al. patent requires for its composition, that all reactions be completed before the composition is used for welding."

Now Union Carbide wishes to read into its patent the very materials it so emphatically disclaimed, and thereby recapture the monopoly upon the process this Court denied it.

Union Carbide asserts (pp. 39-41) that the doctrine of file wrapper estoppel the Court of Appeals applied to bar that result was urged and rejected in the prior proceedings. That is not true.

In the prior case the question so far as concerns the present flux claims was whether claims to "alkaline earth metal silicate" embrace "manganese silicate". The argument was that manganese silicate having been mentioned in the specification but not in the claims was automatically excluded. There was no basis for file wrapper estoppel, and no argument on that ground was made, because in the prosecution of the patent no claims to manganese silicate were presented, rejected, and cancelled, nor did Union

* Respondent's Brief (S.Ct., Nos. 184, 185, October Term, 1948) pp. 14, 38-39, 41, 54, 56.
Appendix to Respondent's Brief (S.Ct., Nos. 184, 185, October Term, 1948) pp. xii, xiii, xv.
Respondent's Brief (S.Ct., No. 2, October Term, 1949) pp. 3, 9, 12-13, 70.

Carbide ever represent to any court, nor did any court hold, that the claims excluded manganese silicate. On the other hand, the present case embodies all those elements —claim, rejection, cancellation, acceptance of limited claims, representation to the courts and holding by the courts that the claims were so limited.

They spell out but one possible result: the doctrine of the *Exhibit Supply* case applies. It estops Union Carbide from asserting now that the claims cover what it told the Patent Office and the courts they do not cover. It is, in short, a doctrine forbidding double dealing.

The Court of Appeals did not "misunderstand." It well understood that claims to a process which have been expunged from the patent cannot be restored by the device of reading the composition claims to cover the process. No more did the Court of Appeals "miss the central point"; it did not "misconceive," it did not "lack understanding," it did not "fail to understand," it was not "unable to appreciate." (Petitioner's Brief, pp. 36, 39, 40, 42, 44). It understood and clearly appreciated what was being attempted as it demonstrated in holding that a patentee cannot talk to the Patent Office and the courts from one side of his mouth in getting and sustaining his patent and from the other in enforcing it. Here no more than in *Shepard* v. *Carrigan,* (1886), 116 U. S. 593, can the patentee (p. 598):

> "**enlarge her patent by argument,** so as to cover elements not falling within its terms, and which she had explicitly abandoned."

III. THERE IS NO ISSUE IN THIS CASE UNDER RULE 52(a).

Union Carbide's appeal to Rule 52(a) is destroyed by *Exhibit Supply Co.* v. *Ace Patents Corp.,* (1942) 315 U. S. 126.

In that case this Court, notwithstanding Rule 52(a), reversed, as a matter of law, a judgment of infringement based on concurrent fact findings of the District Court and the Court of Appeals establishing that the accused device and the patented device were equivalents. This Court held it was immaterial whether there was equivalence in fact. It said (p. 136):

> "We do not find it necessary to resolve these contentions here. Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment."

Similarly, in this case the Court of Appeals held it immaterial that the trial court found (Finding 10, R. 1114-5) the "silicate-forming materials" of the accused fluxes equivalent of the "silicate" of the claims. The accused materials, having been explicitly disclaimed, cannot infringe. Rule 52(a) has no application.

The Court of Appeals confined its decision to a construction of the patent claims. This, like the construction of any legal document, was the resolution of an issue of law.

Petitioner concedes this in its tardy abandonment of its previous contention concerning the meaning of "a major proportion". It says (Pet. Br. 41):

> "the Court of Appeals devotes a substantial portion of its discussion to a subsidiary issue of law—whether 'a major proportion', as properly construed, can mean anything other than 'over 50%.'"

Manifestly, just as construction of the words "a major proportion" taken from the phrase "a major proportion of alkaline earth metal silicate" is a determination of an

"issue of law," so also the construction of the balance of the phrase involves only an issue of law.

CONCLUSION.

The Court of Appeals correctly held the claims, as a matter of law, do not cover the accused fluxes. To ask else is to propose a fraud on the Patent Office, the courts, and the public.

The petition for a writ of certiorari should be denied.

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May 16, 1952.

Office - Supreme Court, U. S.
FILED
MAY 23 1952
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 714

UNION CARBIDE & CARBON CORPORATION,
Petitioner,

vs.

GRAVER TANK & MFG. CO., INC., and
THE LINCOLN ELECTRIC COMPANY,
Respondents.

PETITIONER'S REPLY BRIEF.

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May 22, 1952

The Scheffer Press, Inc.—ANdover 3-6850

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PETITIONER'S REPLY BRIEF.

The Respondents' brief does not answer our petition at all.

It makes but perfunctory reference to the earlier decisions of this Court. A person reading their brief would not realize that this Court had already made a careful study of this case and had rendered two decisions which are landmarks in the patent law.

Our petition is based on direct conflicts between the decisions of this Court and the Court of Appeals' decision.

One has to dig deep into Respondents' brief to find acknowledgment that the 700 fluxes now involved are made of the same ingredients and in the same proportions as the 660 flux condemned by this Court on two occasions. Whether applying slightly less heat to the same raw ma-

terials is sufficient to escape the injunction of this Court, would seem almost to be a self-answering question.

I. FINDINGS OF FACT DISREGARDED.

One important respect in which the Court of Appeals goes directly contrary to the decisions of this Court is in the treatment accorded the findings of fact.

This Court in its earlier decision said:

> "Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations." (Ct. Dec. 44)*

The Respondents' brief, at page 8, has this to say:

> "The Court of Appeals rejected no finding of the trial court. It redrew none. It sorted out the facts found, from the debris to which the trial judge reduced the patent law * * *".

Respondents' brief, however, does not discuss the matter any further. Their brief does not mention any of the extensive findings of fact made by the Trial Court, or purport to summarize the evidence. There is a complete black-out as to the facts. They proceed as if there had never been any trial or any findings, and argue lamely that it is just all a question of law.

* Emphasis added throughout this brief.

We will briefly illustrate how the Court of Appeals went about their process of "sorting out the facts" found by the Trial Court.

The central question of fact was the presence of silicates. Here is the crux of what Judge Dewey had to say on that question:

> "There is sufficient silicate in the defendants' fluxes to accomplish the desired results, and I am abidingly satisfied that the fluxes of the defendants, to-wit: Lincolnweld 770, 780, 760 and 840 are substantially the same with respect to silicates as required by the patent;" (Ct. Dec. 68).

The Court of Appeals, near the end of their decision, start to quote this statement, but they break it right in the middle, thusly:

> "There is no finding upon which this theory can be predicated, as Judge Dewey found on this point only that, 'There is sufficient silicate in the defendants' fluxes to accomplish the desired results * * *.'" (Ct. Dec. 92-93).

The extraordinary thing is that, throughout their discussion, they fail to mention the main part of Judge Dewey's statement:

> "* * * and I am abidingly satisfied that the fluxes of the defendants, to-wit: Lincolnweld 770, 780, 760 and 840 are substantially the same with respect to silicates as required by the patent;" (Ct. Dec. 68).

Here is a finding of fact made by the Trial Judge who saw the witnesses and heard the testimony of the experts, and who was enlightened by the scientific demonstrations and other aids which could not be transmitted in the record on appeal. This was a very strong finding, a finding that he was "abidingly satisfied" as to the substantial identity.

And this was not a question of invention or any other question of law—but a plain determination of fact, whether these colorable variations were substantially the same as the patented compositions.

Yet the Court of Appeals does not even mention this finding anywhere in its opinion. Such a "partial quotation" is plain error.

Here is a further illustration of this "sorting out" process—another plain misquotation. The Court of Appeals accuses Judge Dewey of basing his decision on sameness of function and not on sameness of composition. Thus they say:

> "Judge Dewey in his conclusions of law stated that the accused fluxes infringe because they do 'substantially the same thing,' * * *" (Ct. Dec. 84).

But Judge Dewey actually said:

> "In order for a welding composition or flux to infringe claims 18, 20, 22 and 23 of the Jones, et al. patent, it must be substantially the same thing, * * *" (Ct. Dec. 75).

By substituting the word "do" for "be" at the beginning of their quotation, the Court of Appeals completely alters the sense on the very point they criticize.

The Court of Appeals does not purport to determine that any finding was "clearly erroneous"—does not suggest that any finding lacked support in the evidence—does not weigh or summarize the evidence. They make only passing reference to the record:

> "Rarely have we studied a record which is so replete with contradictions * * *." (Ct. Dec. 89).

The record contains few contradictions of any importance; but even if the Court of Appeals were right, that would

be all the more reason why the appellate court should not trespass upon the findings of fact made by the original trier of fact.

In a recent decision, *United States* v. *Oregon State Medical Society,* handed down April 28, 1952, this Court said:

> "As was aptly stated by the New York Court of Appeals, although in a case of a rather different substantive nature: 'Face to face with living witnesses the original trier of the facts holds a position of advantage from which appellate judges are excluded. In doubtful cases the exercise of his power of observation often proves the most accurate method of ascertaining the truth * * *. How can we say the Judge is wrong? We never saw the witnesses * * * To the sophistication and sagacity of the trial judge the law confides the duty of appraisal.' *Boyd* v. *Boyd,* 252 N.Y. 422, 429." (12 CCH, U.S. Sup. Ct. Bull., pp. 1026-7)

II. PRINCIPLES OF LAW REPUDIATED.

Just as the Court of Appeals rejected the Trial Court's work on the facts, they likewise repudiated the work this Court did in establishing the applicable principles of law in this case. The Court of Appeals did not just change or limit some specific rule of law—they decided contrary to the very spirit of this Court's decision.

This Court said infringement is not to be limited to copying every literal detail:

> "One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form." (Ct. Dec. 52)

Judge Dewey followed and applied the law as established by this Court. Judge Dewey's first conclusion of law was as follows:

> "Infringement is not merely a matter of words but is one of substance. In order for a welding composition or flux to infringe claims 18, 20 22 and 23 of the Jones, *et al.* patent, it must be substantially the same thing, operate in substantially the same way, and produce the same result as the composition described in the claims." (Ct. Dec. 75)

That was based directly on this Court's decision. (See Ct. Dec. 53).

But the Court of Appeals took just the opposite approach, saying:

> "* * * the decision in this case must depend largely upon the meaning attributed to the words * * *." (Ct. Dec. 85)

They set forth the five contentions advanced by Respondent (Ct. Dec. 80) dealing with the words of the patent, and throughout the decision they are entirely preoccupied with verbiage.

The Court of Appeals frankly said they were not looking to this Court for aid in making their decision. This is the way they put it:

> "In the second Supreme Court decision (339 U.S. 605), notwithstanding the court's sweeping denunciation of one who practices a fraud upon a patent and the application of the doctrine of equivalents to the facts before it, there is little, if anything, in the opinion which affords an answer to our instant problem." (Ct. Dec. 82)

Yet these decisions all deal with the same four patent claims 18, 20, 22, and 23—and they deal with fluxes compounded of the same ingredients and in the same pro-

portions. In each instance the question is whether the original 660 flux or the later variation is substantially the same thing as the patented composition.

The decision of the Court of Appeals, if allowed to stand,

> "* * * would place the inventor at the mercy of verbalism and would be subordinating substance to form." (Ct. Dec. 52)

III. RESPONDENTS HAVE FAILED TO ESTABLISH THAT THE CAUSE IS CONCLUDED BY AN ESTOPPEL.

Respondents devote most of their brief to urging that no writ should issue because the case is concluded by "estoppel" (pp. 10-18).

In doing so they necessarily concede, at least *arguendo,* that the facts found by the District Court are without error; that but for the alleged estoppel the judgment of contempt entered against Respondents was correct.

On the face of it, any "estoppel" that would preclude a court from entering a judgment of contempt must needs be very compelling indeed. That is especially so where, as here, the judgment is based on findings made after more than two weeks of trial on the merits, and where, as here, those findings are that the contemnor has continued, with mere colorable variations, the practices forbidden by injunction and when "common sense should have told [them] that they were getting too close" (Ct. Dec. 69).

This Court will certainly be slow to conclude that an injunction issued pursuant to its mandate can so easily be abrogated.

Respondents heatedly deny as "not true" our statement that the defense of file wrapper estoppel was urged and rejected in the prior proceedings in this case (their brief, p. 19).

We cited (see footnote at p. 40), the very pages in their briefs in which Respondents had made the argument, but that seems not to have been enough. So, to put the matter straight, we have set out here, side-by-side, their argument in the very first brief they filed in this case back in 1947 and that which Respondents make in their brief before this Court today:

From Respondents' Brief Before Judge Swygert pp. 78-79	From Respondents' Present Brief Before this Court, pp. 14-17
1947	1952
"Plaintiff's position in respect to manganese oxide is therefore wholly untenable, since admittedly the exhibition by a metal oxide of a basic characteristic is insufficient to determine its usefulness in the composition of the patent. Moreover, as we have pointed out in the Statement of the Case (*ante*), plaintiff is precluded by the application of the patent in suit from making any such contention. Thus, as previously noted in our discussion of the file wrapper (see Statement, *ante*), in their first abandoned application, Serial No. 657,836 (Pltf. Exh. 125, p. 11), the pat-	"Petitioner limited its claims to the reacted product, silicate, because the Patent Office required it to do so. It sought a claim to cover the components which under the heat of the welding arc form silicate. This would have given it a monopoly of most of the prior art; it was repeatedly refused by the Patent Office. Union Carbide accepted the more limited claims. "The first four claims in the original, subsequently abandoned, first application defined the flux as:

entees undertook to define their welding composition as follows:

"'1. A fluxing material for electric arc welding consisting of two components, one acid and one basic.'

"*Upon rejection* of this claim as vague and indefinite and not in compliance with R.S. 4888 (see Office action Id. 25) *the claim was cancelled* and the following substituted (Id. 26):

"'2. A finely-divided unbonded fusible electric welding composition containing a major proportion of a compound having a basic component and an acid component.'

"*This claim in turn was rejected* (Id. p. 31) for the same reason and for the additional reasons that it was inaccurate, and that it was unpatentable over the prior patent to Severance No. 429,777 (see Deft. Exh. 146). *Thereupon said claim was cancelled* and the application passed to allowance with claims that are obviously much narrower in scope. Nor was any claim obtained, thus calling for a composition containing a

"• • • 'consisting of two components, one acid and one basic.' (E.g., claim 1, II. O.R. 1052).

"These claims were rejected. (II. O.R. 1062). They were then cancelled (II. O.R. 1063). Simultaneously additional claims 22 to 27 were added by amendment, calling for:

"• • • 'a compound having both a basic component and an acid component' (II. O.R. 1064).

• • • • • • • • •

"Having sought and having been denied claims covering the component materials to form a silicate, and having accepted claims confined to the reaction product, silicate, Union Carbide cannot now have its patent read to cover not only the silicate it claimed but also the components it abandoned.

• • • • • • • • •

compound made up simply of a basic component and an acid component, either in the prosecution of the patentees' second abandoned application or of their third application on which the patent in suit was finally granted.

"On this record it is clear that none of the composition claims here in issue can by construction be read to cover what was thus eliminated from the patent. See *Schriber-Schroth Co.* v. *The Cleveland Trust Co.*, 311 U.S. 211, 61 S. Ct. 236, 85 L.Ed. 132, 137, and cases there cited. By the same authority, the cancellation of the foregoing claims amounts to a disclaimer and plaintiff may not now, by resorting to the doctrine of equivalents, give to the claim here in issue a scope which it might have had without the amendments thus made in the claims of the patent."

"Nor can a claim to the components required to form silicate be recaptured in the name of equivalents. This, too, was settled in the *Exhibit Supply* case.

* * * * * * * * *

"In *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, (1940), 311 U.S. 211, this Court similarly held (p. 221): * * *."

We stand on our original assertion that this file wrapper estoppel argument was simply warmed over from the original proceeding; that the same items from the Patent Office file history which are now said to justify Respondents' undercooked flux are the same ones which were said to justify their use of manganese in lieu of alkaline earths. The only difference is that, whereas the argument failed

in all courts before, it has here succeeded in the Court of Appeals.

So far as authorities go, Respondents stake their argument on *Exhibit Supply Co.* v. *Ace Patents Corp.*, (1942) 315 U. S. 126. So, too, did the Court of Appeals, but by an acknowledged extension of the case and not by treating it as the square authority which Respondents assert it to be (p. 16, paragraph 60). The Court of Appeals confessed it had found no case directly in point (Ct. Dec. 84).

The Court of Appeals, even though it reversed the District Court, failed to evince the dogmatic certainty which Respondents' brief displays. Indeed, the Court of Appeals, in discussing the application of the doctrine of estoppel in a situation such as the present, said (Ct. Dec. 84):

> "• • • we find no case where this question has been discussed • • •."

That, in itself, is a persuasive circumstance for grant of the writ. That the Court of Appeals followed a false lead in applying an estoppel, we have demonstrated in our Brief in Support of the Petition, particularly in Point IV (pages 39-45). In so doing, the Court below proceeded, we submit, in direct contradiction of the law governing equivalents as laid down by this Court in this very case (Ct. Dec. 51). Resolution of such a conflict imposes an important reason for grant of the writ.

The decision of this Court, in the *Exhibit Supply* case, entails, we submit, no collision with the doctrine of equivalents as expounded by this Court in the present case (Ct. Dec. 51), and as subsequently applied by the District Court in the present proceeding.

In *Exhibit Supply Co.* v. *Ace Patents Corp.*, (1942) 315 U. S. 126, the controlling words in the claim had been

inserted in that claim by deliberate amendment. Not so here. In the present instance, Respondents argue that because other claims had preceded the claims in suit, that because those other claims were so indefinite in scope as to be rejected and withdrawn because of that "indefiniteness", that, therefore, the claims in suit are to be denied the benefit of the doctrine of equivalents (their brief pp. 18-20). This Court has once held those same claims, with that same history in the Patent Office, to be entitled to the application of the doctrine of equivalents (Ct. Dec. 51). No reason appears why that result should be changed now.

In the *Exhibit Supply* case, this Court was at some pains to distinguish carefully the precise situation with which it was dealing and in which the particular claim phrase, which it denied the benefit of an equivalent, had been inserted by amendment after rejection. Thus it said (p. 136):

> "Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed a 'conductor means embedded in the table,' a very different issue is presented when the applicant, in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one 'carried by the table.' "

That "very different issue" is not presented on the present record.

IV. GENERAL COMMENT ON RESPONDENTS' BRIEF.

It is not just by chance that Respondents' brief fails to meet our petition for certiorari and fails to discuss the question whether this Court should review the decision of the Court of Appeals. Finding it impossible to do this,

Respondents' counsel followed the only course they could and attempted to present some argument as to the substantive merits.

In the absence of any evidence or findings favorable to the Respondents, they resort to characterizations, and at some points their brief tends to become strident. We especially deplore the following sentence on page 22:

> "To ask else is to propose a fraud on the Patent Office, the courts, and the public."

As a characterization of Judge Dewey's decision, this does grave injustice to an experienced and eminent jurist.

Respondents' brief has many statements as to what we have claimed, or concede, or abandoned, and the like. The record will speak for itself. It is not worth taking time to tag the misstatements. They are perhaps due to the fact that Respondents have changed counsel several times and new counsel have come into the case since the appeal from Judge Dewey's decision.

Perhaps that circumstance likewise accounts for the erroneous premise on which they level their intemperate attack (pp. 13-14) upon us for use of the term "incipient silicate". They say the term was not used by Dr. Willard or any other witness. They are mistaken.

In the charts which Dr. Willard prepared (Pl. Ex's. 70 and 73, R. 227-229, 237-238) he indicated by his notes the basis of his opinion that each of the elements of the claims finds its response in the presently accused fluxes just as it did in the earlier 660 flux. And in those notes Dr. Willard states:

> "Substantially half of the silica is chemically combined with the basic oxides, to form silicate, * * * The remaining half of the silica and corresponding portion of the basic oxides are uniformly dispersed in finely divided form to constitute an incipient silicate * * *".

Use of the term by Dr. Willard, dean of the field of analytical chemistry, renders ridiculous Respondents' charges of "unscientific", "afterthought", and the like.

In an effort to belittle our invention, Respondents' brief has much talk about Robinoff. The Robinoff flux was merely a mechanical mixture of natural clay, lime, and ferromanganese (I O.R. 514-15). The difficulties and defects in Robinoff welding formed the starting point for the research work of Jones *et al.*, as was specifically stated in the patent (I O.R. 955). Judge Swygert's decision mentioned the Robinoff clay flux when he said with reference to our invention:

> "Furthermore, the welding speeds made possible by it dwarf those of any other method, and the welds produced by it are of the highest quality in contrast to the great amount of porosity contained in the welds produced by the so-called clay flux process." (Ct. Dec. 2)

CONCLUSION.

This case has already been briefed and argued twice before this Court, and this Court may feel that the Court of Appeals' decision is so clearly in error as to make further argument unnecessary. This Court may grant the petition and summarily reverse the judgment of the Court of Appeals and reinstate the Trial Court's judgment. *Securities & Exchange Commission* v. *Otis & Co.*, (1949) 338 U. S. 843.

Summary disposition of this contempt proceeding is appropriate in view of the circumstances. The writ of permanent injunction was issued pursuant to this Court's mandate. The patent will expire next year, June 9, 1953. Respondent began selling the 660 flux in 1942 and con-

tinued until stopped in June 1950, and is still today selling fluxes compounded from the same ingredients and in the same proportions. These fluxes were all copied from the patent and Respondent has had the benefits of the patent for ten years without paying a single cent.

Certainly the decision of the Court of Appeals should not be allowed to become a part of the body of Federal law, leaving it in disorder and confusion. It is imperative in the widespread public interest that there be a further review by this Court.

The writ should issue.

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May 22, 1952